

Application No. 10/603,449

REMARKS

The copending applications have been updated as suggested by the Examiner on page 2 of the Official Action, and the rejection of certain claims under 35 U.S.C. 112 has been addressed, and it is believed that the claims have been clarified in accordance with the Examiner's suggestions. In this regard, Claim 6 has been canceled without prejudice.

The rejection of Claims 1, 12 to 16 and 23 to 25 under 35 U.S.C. 103(a) as being unpatentable over Patel et al. '684 in view of Hopper et al. is respectfully traversed.

The specific comments rendered by the Examiner on pages 2 and 3 of the Official Action have been reviewed. It is not believed that the Examiner has established a prima facie case of obviousness in that the Examiner has not pointed to Applicants where in the '684 Patel et al. patent there is illustrated the combination of components as recited in Claim 1 including the adding of a silicate salt. The disclosure referred to by the Examiner in column 18, lines 59 to 68, does not illustrate a silicate salt. For example, cationic surfactants illustrated include alkylbenzyl methyl ammonium chlorides and the like, there being no disclosure with reference to a silicate salt. Moreover, the '684 patent is directed to a toner process wherein there is utilized an acicular magnetite and a colorant with a latex containing a crosslinked resin, a latex containing a resin free of crosslinking, a wax dispersion, a resin, and a coagulant, which is substantially dissimilar, it is believed, than, for example, the rejected Claim 1.

Concerning the Hopper et al. '102 patent, there is no teaching or disclosure pointed out by the Examiner wherein there is selected the combination of a coagulant containing a metal ion and a silicate salt. Even if the Hopper et al. patent can be combined with the '684 reference, the Examiner has not established a prima facie case of obviousness in that the combination of utilizing a coagulant containing a metal ion and adding a

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silicate salt, reference Claim 1, is not believed to be illustrated in the combination of references, particularly without a hindsight analysis approach and without the benefit of the teachings of the present application.

With respect to the rejection of Claims 26 to 31 under 35 U.S.C. 103(a), similar comments as presented hereinbefore are believed to be equally applicable to this rejection. Accordingly, this rejection is traversed. In addition to the heating, that is the first and second heating recited in Claim 26, there is also recited the utilization of a coagulant and a silicate salt, and it is not believed that the Examiner has established that a silicate salt is illustrated or obvious from the teachings of the Patel et al. '684 patent for the reasons as mentioned herein.

It is noted that Claims 2, 3, 5, 7, 11, 17, 18 and 22 to 27, and also 9 and 10, have been objected to as being dependent on a rejected claim, but would be allowable if rewritten in independent form. In view of the arguments presented herein, Applicants have not accomplished this except for Claim 2.

With respect to the provisional double patenting rejection, reference page 4 of the Official Action, Applicants traverse this rejection since it is believed that the Examiner has not established that the claims of the present application, and of the copending application are substantially similar to warrant a provisional double patenting rejection. Nevertheless, Applicants are submitting herewith, to expedite prosecution and for that purpose only, a Terminal Disclaimer whereby any patent resulting from the present application will expire simultaneously with any patent resulting from related copending application 10/606,330 subject to the conditions recited in the disclaimer.

Accordingly, it is respectfully requested that the Examiner reconsider his positions and provide Applicants with a Notice of Allowance.

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In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby requested to call Eugene O. Palazzo, at Telephone Number 585-423-4687, Rochester, New York.

Respectfully submitted,



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